

Appl. No. 09/583,891  
Amdt. dated August 13, 2003  
Reply to Office Action of March 13, 2003

#### REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Upon entry of this amendment, claims 1, 4-10 and 21-24 will remain pending, with claims 21-24 being withdrawn from consideration.

The Title of the Invention is being amended as indicated above, since the Examiner has indicated that the previously amended Title is unacceptable. Applicants respectfully request approval of the amended Title.

Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, because the Examiner contends that the preamble of claim 1 "is incomplete and incompatible with the last step in the claim".<sup>1</sup> This rejection is respectfully traversed.

Specifically, the preamble of claim 1 recites "a method for analyzing a microbiological sample contained in at least one sample well" and the last step of the claim recites "mathematically combining said result values to provide at least two growth indicator values, each representing a respective growth characteristic of said microbiological sample, wherein at least one of said growth indicator values represents a redox state of said microbiological sample, and wherein another of said growth indicator values represents a turbidity value of said microbiological sample". Applicants respectfully submit that this mathematically combining step does indeed perform analyzing functions by producing the growth indicator values that represent the redox state and

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<sup>1</sup> Applicants respectfully note that claims 2 and 3 were canceled in the previous Amendment and therefore should not be included in this rejection.

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turbidity value of the microbiological sample. In other words, an indication of the redox state and turbidity value of the microbiological sample is an analysis of the sample. Furthermore, Applicants believe that the use of the term "respective" in this claim is proper, in that each of the growth indicator values represents a respective growth characteristic, that is, one value represents a redox state and the other value represents a turbidity value.

For these reasons, Applicants respectfully request that the Examiner withdraw the § 112, second paragraph, rejection of the claims.

Turning now to the art-based rejections, claims 1 and 4-10 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,372,485 to Clark et al. in view of U.S. Patent No. 4,448,534 to Wertz et al.. This rejection is respectfully traversed.

In particular, Applicants respectfully submit that as indicated on the face of the Clark et al. patent, the Clark et al. patent is assigned to Becton, Dickinson and Company, which is the assignee of the present application. Applicants respectfully submit that Becton, Dickinson and Company owned the Clark et al. patent and the present application "at the time the invention was made". Applicants further respectfully submit that the Clark et al. patent is "prior art" under 35 U.S.C. § 102(e) since the application from which it issued was filed in the United States prior to the filing date of the present application and did not issue until after the filing date of the present application. Hence, Applicants respectfully submit that in accordance with 35 U.S.C. § 103(c), a reference under 35 U.S.C. § 102(e) that is commonly owned with the present application cannot be relied

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upon in a rejection under 35 U.S.C. § 103. Therefore, Applicants respectfully request that this rejection be withdrawn.

Applicants further note, however, that an International Application claiming benefit from the Clark et al. patent was filed, and had published on November 26, 1998 as WO 98/53301, a copy of which is attached for the Examiner's convenience. Applicants further respectfully submit that even if the rejection based on the Clark et al. and Wertz et al. patents were permissible under 35 U.S.C. § 103, one skilled in the art would not have been motivated to modify the Clark et al. system in view of the teachings of Wertz et al., and thus would not have found the present invention as recited in claims 1 and 4-10 obvious over the teachings of Clark et al. in view of Wertz et al.

In this regard, Applicants submit that as identified by the Examiner, the Clark et al. patent teaches an automated microbiological testing apparatus and method that employs multiple light sources. The Examiner admits that unlike the embodiment of the present invention defined in independent claim 1, the Clark et al. patent fails to teach or suggest that its system is capable of generating two growth indicator values, each representing a respective growth characteristic of the sample. The Examiner further admits that the Clark et al. patent fails to teach or suggest that its system is capable of measuring a turbidity value of the sample. Nevertheless, for these features, the Examiner relies on the teachings of the Wertz et al. patent, and contends that one skilled in the art would have found it obvious to modify the Clark et al. system in accordance with those teachings to achieve the embodiments of the present invention recited in claims 1 and 4-10. Applicants respectfully disagree.

The Wertz et al. patent teaches an antibiotic susceptibility testing system that performs an optical analysis on a sample to determine minimum inhibitory concentrations (MICs) of the sample. Applicants note, however, that unlike the Clark et al. system and the claimed embodiments of the invention which employ multiple light sources of different wavelengths, the Wertz et al. patent teaches that the use of a *single light source* is preferable (see, for example, the Abstract, column 7, lines 21-24, column 24, line 60 through column 25, line 2 and item 26 in Figures 2-4). Granted column 14, lines 40-46 of the Wertz et al. patent teaches that a plurality of light sources can be used. However, this passage suggests that the plurality of light sources should act as a single light source “which will provide light of equal intensity directed to each well”.

Accordingly, Applicants respectfully submit that because the type of system employing a single light source (or multiple light sources acting as a single light source) is unrelated to the multiple light source system taught by Clark et al., one skilled in the art would not have been motivated and thus, would not have found it obvious, to modify the Clark et al. system in accordance with the teachings of the Wertz et al. patent to achieve the embodiment of the present invention even as defined in independent claim 1. Moreover, Applicants note that neither the Clark et al. patent, nor the Wertz et al. patent, teach or suggest the specific steps of “generating a result value representative of each *respective resultant light wavelength*” and “mathematically combining said result values” (which were generated based on the *different* light wavelengths) to provide *at least two growth indicator values*. In other words, neither patent viewed alone or in combination teaches the use of multiple light wavelengths to obtain multiple growth indicator values.

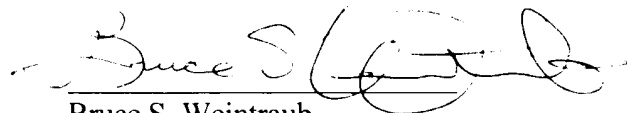
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Applicants further note that the Clark et al. and Wertz et al. patents fail to teach or suggest the specific grouping of sample well characteristic values, and the comparing of the respective groups, as recited in dependent claim 10.

For all these reasons, Applicants respectfully submit that independent claim 1 and dependent claims 4-10 should be allowable. However, should the Examiner find it necessary to issue another Office Action, Applicants request that that action be made non-final since such an Office Action would necessarily require that the Examiner cite different art in a rejection that is not necessitated by any amendments made by Applicants (Applicants note that the amendments made to claim 1 in the previous Amendment merely incorporated the limitations of dependent claims 2 and 3 into claim 1).

In view of the above, it is believed that the subject application is in condition for allowance, and notice to that effect is respectfully requested. However, should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number indicated below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Bruce S. Weintraub", with a stylized flourish extending from the end.

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